

## **REMARKS**

### **Status Of The Claims**

Claims 1-2 are currently amended.

Claims 22 and 23 are new.

Claims 1-3, 22, and 23 are pending.

New claims 22 and 23 are supported by the specification and are alternate forms of claims 2 and 3.

### **Response To Priority**

The Examiner states that a reference to the prior application No. 09/682,597 filed September 25, 2001 is not disclosed in the specification. In response, Applicants amend the specification to refer to prior application No. 09/682,597 filed September 25, 2001. Applicants would also like to point out that a reference to said prior application was previously submitted within the time period set forth in 37 CFR § 1.78(a)(2)(ii) in a preliminary amendment filed December 4, 2003. The information concerning the benefit claim was recognized by the Patent and Trademark Office as shown by its inclusion on the first filing receipt, a copy of which is attached herewith. Therefore, the amendment to the specification filed in this response is sufficient to allow the current application to claim benefit from application No. 09/682,597.

### **Response To Claim Objections**

Claim 1 is objected to because of (1) the typographical error “rise” at line 5; and (2) the recitation “plants” at steps 4 and 5 of the claimed method, which is not in number agreement

with “plant” at step 3. In response, Applicants amend claim 1 to replace “rise” with “rice” and to amend step 3 to read “a wheat plant or wheat plants” as suggested by the Examiner.

**Claim Rejections -- 35 U.S.C. § 112 (indefinite)**

Claim 3 is rejected under 35 U.S.C. § 112 as being indefinite. The Examiner states that it is unclear if the progeny seeds comprise the DNA construct or if the claim encompasses non-transgenic seeds. Claim 3 is amended to recite the phrase “wherein said seed comprises the construct of claim 1.”

Claim 3 is also rejected under 35 U.S.C. § 112 as being indefinite because the limitation “The progeny seeds” lacks proper antecedent basis in claim 2. The claim is amended to read “A seed of” in lieu of “The progeny seeds.”

**Claim Rejections -- 35 U.S.C. § 103**

Claims 1-3 are rejected under 35 U.S.C. § 103(a) as being obvious over Anderson *et al.* (U.S. Patent No. 6,645,765). The applied reference has a common inventor and assignee with the instant application. In response, Applicants submit a statement pursuant to MPEP § 706.02(l)(1) and § 706.02(l)(2) to disqualify U.S. Patent No. 6,645,765 under 35 U.S.C. § 103(c) as prior art in a rejection under 35 U.S.C. § 103(a).

35 U.S.C. § 103(c)(1) states “subject matter developed by another person, which qualifies as prior art under . . . (e) . . . of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

Applicants submit herewith a statement in accordance with MPEP § 706.02(l)(2)(II) stating that the instant application and U.S. Patent No. 6,645,765 were commonly owned by Monsanto Technology LLC at the time the claimed invention was made. Also in accordance with MPEP § 706.02(l)(2)(II), this statement alone is sufficient evidence to disqualify U.S. Patent No. 6,645,765 from being used in a rejection under 35 U.S.C. § 103(a) against the claims of Application Serial No. 10/727,423.

Claims 1-3 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhou *et al.* (*Plant Cell Reports* 15:159-163, 1995) in view of Lundquist *et al.* (U.S. Patent No. 5,990,390) and Brown *et al.* (WO 99/46396). According to the Examiner, it would have been obvious to "modify the teachings of Zhou *et al.* to make a glyphosate tolerant transgenic wheat plant using a DNA construct comprising said first and said second expression cassette as taught by Lundquist *et al.* and Brown *et al.*, respectively."

Applicants respectfully disagree. None of the references cited by the Examiner teach or suggest the combination of the elements of the DNA construct of the present invention to obtain increased tolerance to glyphosate. Although Brown *et al.* disclose the second expression cassette in Figure 6A, Brown *et al.* do not teach to combine said second expression cassette with another cassette so as to increase tolerance to glyphosate. In fact, Brown *et al.* teach that the combination of two cassettes serves to inhibit the expression of one of the cassettes by the other (see page 15, lines 1-4, and lines 15-17).

The current invention teaches that transgenic wheat plants transformed with a construct having two expression cassettes are superior in tolerating glyphosate as compared to plants transformed with a construct of a single expression cassette (see present specification at page 16). In the current invention, the effects of the first and second expression cassettes are

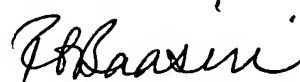
incremental. For example, Table 1 provides a comparison of the efficacy between single and double expression cassettes in conferring glyphosate tolerance in wheat plants. According to Table 1, pMON42411 and pMON30167 (constructs with a single expression cassette) produce fewer events with vegetative and/or reproductive tolerance than the double expression construct, pMON30139. In contrast, Brown *et al.* teach how to negate the effect of the first cassette by the second cassette. Thus, according to Brown *et al.*, the effect produced by combining the first and second expression cassettes is regressive, not cumulative.

In view of the foregoing argument, Applicants request that the rejection of claims 1-3 under 35 U.S.C. § 103(a) be withdrawn.

#### Fees

A request for a three-month extension of time and the authorization for the associated fee are filed concurrently with this paper. In addition, the Commissioner is hereby authorized to deduct any additional fees under 37 C.F.R. §§ 1.16 to 1.21 relating to the enclosed materials, from Deposit Account 08-3038/11898.0226.DVUS00.

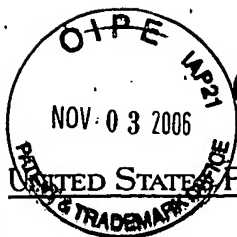
Respectfully submitted,



Rudeina A. Baasiri, Ph.D.  
Reg. No. 47,398  
Agent for Assignee  
MONSANTO TECHNOLOGY LLC

Customer No. 45,607  
HOWREY LLP  
1111 Louisiana Street, Suite 2500  
Houston, Texas 77002  
(713) 654-7648

Date: Nov 1<sup>st</sup>, 2006



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
✓ 10/727,423	✓ 12/04/2003	1761	✓ 770	✓ 38-21(52232)C	✓ 3	✓ 3	✓ 1

CONFIRMATION NO. 8132

## FILING RECEIPT



\*OC000000012255626\*

✓ 27161  
MONSANTO COMPANY  
800 N. LINDBERGH BLVD.  
ATTENTION: G.P. WUELLNER, IP PARALEGAL, (E2NA)  
ST. LOUIS, MO 63167

Date Mailed: 04/01/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## ✓ Applicant(s)

Guilan Chen, Chesterfield, MO;  
Catherine M. Hironaka, Dublin, CA;  
Hua-Ping Zhou, Chesterfield, MO;

APR - 6 2004

## ✓ Domestic Priority data as claimed by applicant

This application is a DIV of 09/682,597 09/25/2001 PAT 6,689,880  
which claims benefit of 60/236,762 09/29/2000  
and claims benefit of 60/236,653 09/29/2000

## Foreign Applications

If Required, Foreign Filing License Granted: 03/31/2004

Projected Publication Date: 07/08/2004

Non-Publication Request: No

Early Publication Request: No

Title

